

REMARKS

In the Office Action, claims 1-11, 17-21, 23-29 and 32-34 were rejected, and claims 22 and 31 were objected to by the Examiner. Applicant thanks the Examiner for indicating the allowability of claims 22 and 31. Independent claim 24 has been amended to add the language of claim 31 and intermediate claim 28, and thus claim 24 along with its dependent claims 25-27 and 29 should be in condition for allowance. The language of claim 22, indicated as allowable, has been added to independent claim 18. Although the language of the intermediate claims has not been added, claim 18 and its dependent claims 19-21 and 23 are believed to be in condition for allowance.

Claims 1, 18, 23, 24 and 29 have been amended, claims 22, 28 and 31-34 have been canceled without prejudice, and claims 1-11, 17-21, 23-27 and 29 remain pending in the present application. All claim amendments are fully supported throughout the written description and figures of the specification.

Claims 1 and 7-8 were rejected under 35 USC 102(b) as anticipated by the Carter reference, US Patent No.: 3,975,117. Independent claim 1 has been amended to clarify certain aspects of the invention.

The Carter reference discloses a motor driven, inducer-equipped, centrifugal pump having pumps located outside of its motor housing 17. In fact, the motor 30 and the pumps 37, 56 and 79 are not within the same housing. Accordingly, the Carter reference does not disclose an "internal lubricant pump extending around the entire circumference of the shaft" as presently recited in claim 1 and thus dependent claims 7 and 8. Additionally, the Carter reference does not disclose a rotor and a stator disposed within a motor housing combined with a shaft, at least partially disposed within the motor housing, and the internal lubricant pump referenced above. Accordingly, claims 1, 7 and 8 are believed patentably distinguishable over the Carter reference.

Claims 1-5 were rejected under 35 USC 102(e) as anticipated by the Gilbert reference, US Patent No.: 6,422,346. Independent claim 1 has been amended to clarify aspects of the invention, and the rejection under the Gilbert reference is believed not applicable.

The Gilbert reference is directed to a gas compressor having a crankcase rotatably supporting a drive shaft. The drive shaft 12 is connected to a compression generating structure, such as a conventional cylinder-piston combination of a compressor. The shaft also is connected to a motor means 16. Oil passage means 18 is formed in the shaft to convey lubricating oil to various portions of the compressor. (Column 3, lines 5-15). The Gilbert reference does not disclose an "internal lubricant pump extending around the entire circumference of the shaft" as recited in independent claim 1 and dependent claims 2-5. Furthermore, the shaft discussed in the Gilbert reference is the pump shaft rather than the motor shaft. (See also column 4, lines 5-9). Accordingly, claims 1-5 are believed patentably distinguishable over the Gilbert reference.

Claims 18-19, 24-26, 32 and 34 were rejected under 35 USC 102(b) as anticipated by the Traylor et al. reference, US Patent No.: 6,017,198. However, this rejection is believed to be moot. Independent claim 18 has been amended to add the language of former claim 22, independent claim 24 has been amended to add the language of former claims 28 and 31, and claims 32 and 34 have been canceled without prejudice.

Claim 6 was rejected under 35 USC 103(a) as unpatentable over the Gilbert reference in view of the Klumpp et al. reference, US Patent No.: 5,211,544. Claim 6 depends from amended independent claim 1 and is believed patentable for the reasons provided above with respect to independent claim 1, as well as for the unique subject matter recited in claim 6. The Klumpp et al. reference does not obviate the deficiencies of disclosure with respect to the Gilbert reference. Furthermore, even if the references did disclose all the elements of claim 6, the combination is improper as discussed below.

Claims 9-11 and 24-29 were rejected under 35 USC 103(a) as unpatentable over the Parmeter et al. reference, US Patent No.: 5,828,149, in view of the Klumpp et al. reference. As discussed above, claim 28 has been canceled without prejudice, and independent claim 24 has been amended to incorporate the language of former claims 28 and 31 to place the claim into condition for allowance. Accordingly, claim 24 and dependent claims 25-27 and 29 should be in condition for allowance. Regardless, the rejection, particularly as it applies now to claims 9-11, is strongly traversed.

First, the combination of the Parmeter et al. reference and the Klumpp et al. reference does not disclose each and every element of the subject claims and, secondly, the combination of references is improper. With respect to disclosure of elements, the Parmeter et al. and Klumpp et al. references, taken alone or in combination, do not disclose, teach or suggest a submersible motor having a gear pump that comprises "first and second gears adapted to pressurize the lubricant" as recited in claim 9 and its dependent claims.

The Parmeter et al. reference discloses an axial rod 59 with a helical flight 61 rigidly attached to the rod 59. The unit is secured within a shaft bore 53. (Column 3, lines 6-15). Accordingly, the pump is not external to the shaft. Furthermore, the Klumpp et al. reference merely states that "circulation impellers for a hydraulic pump can be "elements of a gear pump, trochoidal pump, sickle pump, Eaton pump, screw pump or vane pump." The reference, however, makes no further description or illustration as to how circulation impellers can be elements of a gear pump or the other pumps listed. Accordingly, the disclosure is insufficient to disclose, teach or suggest elements of the subject claims.

Secondly, even if the disclosure of the two references were supplemented to disclose each and every element of the subject claims, the combination of references is improper. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). In the present case, there is no motivation to combine the references and, in fact, there is a teaching away from the combination.

In the Official Action, the Examiner states that the Parmeter et al. reference employs “an impeller pump rather than a gear pump in order to pump the lubricant.” The Examiner further states that the Klumpp et al. reference teaches that “the two pumps were art recognized equivalents. . . .” However, these are not the teachings of the two references.

In the Parmeter et al. reference, prior art pumps were discussed as having “an impeller that rotated within a diffuser.” (Column 1, lines 38-39). In contrast, the Parmeter et al. invention is described as an inducer pump for circulating lubricant that comprises “a rod with a helical flight mounted to the rod.” (Column 1, lines 54-56). The helical flight is described as extending substantially to the side wall of the shaft bore and defining a helical fluid path between the side wall of the axial bore and the rod. (Column 1, lines 56-58). In other words, the impeller style pumps of the prior art had been replaced by the rod and helical flight disposed internally within a shaft bore. Accordingly, the Parmeter et al. reference does not teach the use of an impeller pump, and thus any comparison of impeller pumps to gear pumps in the Klumpp et al. reference provides no motivation to combine the Klumpp et al. reference and the Parmeter et al. reference. In fact, the Parmeter et al. reference actually teaches away from such combination by describing the use of a helical pump instead of an impeller pump.

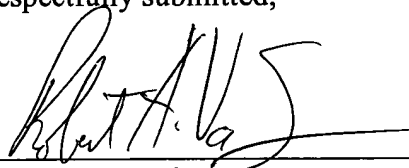
Furthermore, the Klumpp et al. reference is not a proper reference to rely on for the teaching of a gear pump as recited in the present application, because there is no description or illustration of any type of gear pump. Additionally, the obscure description in the Klumpp et al. reference of "circulation impellers that can be used for the invention can be of any sort, for example, elements of a gear pump, . . ." does not show, teach or provide any indication as to how a gear pump can be combined with the Parmeter et al. device. The drafter of the Klumpp et al. reference states that elements of a gear pump may be used without any further description as to which elements and as to how they would be substituted for an impeller.

Accordingly, the Parmeter et al. and Klumpp et al. references do not disclose the elements of the subject claims, and even if the disclosure could be supplemented to disclose such elements, the combination of the Parmeter et al. and Klumpp et al. references is improper. Accordingly, currently pending claims 9-11 (as well as 24-29) are patentably distinguishable over the cited references.

Claims 20-23 and 33 were rejected under 35 USC 103(a) as unpatentable over the Traylor et al. reference in view of the Parmeter et al. reference. However, this rejection is believed to be moot. Claims 20-23 ultimately depend from independent claim 18 which is believed to have been placed into condition for allowance as discussed above. Claimed 33 has been canceled without prejudice.

In view of the foregoing remarks, the pending claims are believed patentable over the cited references. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert A. Van Someren', written over a horizontal line.

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